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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,368	02/10/2004	Edward J. Stashuk JR.	067439.0161	9915
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 06/12/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/775,368

Applicant(s)

STASHLUK ET AL.

Examiner

THUY-VI NGUYEN

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02/10/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-854)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date See Continuation Sheet

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :07/02/04;09/21/07;11/06/07; 01/08/08; 02/08/08 .

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1- 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1 (step e), 14 (step e), 28 (c), there are lack of antecedent and basis for the term "*the business rules*" as recited in the claims. Appropriate correction is required in the indicted claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 28-29, 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hauser et al. (US 6,536,659). Herein after is referred as Hauser.

Regarding claim 28, Hauser discloses a computer product for providing merchandise return labels for enabling a customer to ship a package containing one or

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more items previously acquired from a merchant during a unique transaction, comprising programming operable to:

access item data representing at least one detail about the item [...*transmit the return merchandise data*; abstract; col.2, lines 11-13];

access transaction data representing at least one detail about the transaction associated with the item [...*data identify the merchant and the merchandise purchased by customer*; col. 2, lines 13-16; col. 4, lines 9-15];

correlate the item data and transaction data with a set of stored business rules; wherein the business rules represent guidelines for determining at least one shipping parameter selected from the group of: shipping destination or shipping rate [...figure 1 shows the correlate the item and data transaction and figure 2 shows the shipping parameter (*shipping via carrier or US Post*) selected from the group of shipping destination (*i.e. retailer, donate to charity, salvage*; col. 6, lines 50-65];

generate a machine readable code, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction [...*label (52) includes the address for returns* (shipping origin) *and a bar code to identify the merchant and merchandise being returned* (identification of the transaction); abstract; col. 6, lines 21-27; and figures 2 and 6]; and

format the return label, such that the return label contains the machine readable code and complies with shipping label specifications of a carrier [...*return label having a machine readable code (52)* figure 2; and *is applied in the package to ship via USP or shipper*; col. 4, lines 16-30; figure 1, step 18-20].

Regarding claim 29, Hauser discloses wherein the programming is further operable to access customer data representing at least one detail about a customer associated with the transaction, to further correlate customer data with the business rules [...*business rules such as sorting the merchandise, verify contents against database, disposition to merchandise*; figure 2].

Regarding claim 31, Hauser discloses wherein the shipping parameters further may comprise choice of carrier [figure 2].

Regarding claim 32, Hauser discloses wherein the shipping parameters further may comprise package disposition [figure 2].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-27, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (US 6,536,659) in view of Holtz et al (2004/0128265). Herein after is referred as Hauser and Holtz.

Regarding claim 1, Hauser discloses a computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the steps of:

accessing item data representing at least one detail about the item [...*transmit the return merchandise data*; abstract; col.2, lines 11-13];

accessing transaction data representing at least one detail about the transaction associated with the item [...*data identify the merchant and the merchandise purchased by customer*; col. 2, lines 13-16; col. 4, lines 9-15];

accessing customer data representing at least one detail about a customer associated with the transaction [...*customer contact information; merchandise purchase by customer*; col. 2, lines 13-17; col.4, lines 9-15];

correlating the item data, transaction data, customer data, and package data, with a set of stored business rules; wherein the business rules represent guidelines for determining at least one shipping parameter selected from the group of: choice of carrier, shipping destination, shipping rate, or package disposition [... shipping parameter selected from the group of *package disposition*; figures 1-2; col. 6, lines 50-65];

generating a machine readable code, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction [...*label (52) includes the address for returns (shipping origin) and a bar code to identify the merchant and merchandise being returned (identification of the transaction); abstract*; col. 6, lines 21-27; and figures 2 and 6]; and

formatting the return label, such that the return label contains the machine readable code and complies with shipping label specifications of a carrier [...*return label having a machine readable code (52) figure 2; and is applied in the package to ship via USP or shipper*; col. 4, lines 16-30; figure 1, step 18-20].

However, Hauser fails to indicate accessing package data representing at least one detail about the package in which the item is expected to be shipped.

In the similar process for returning the merchandise, Holtz discloses accessing package data representing at least one detail about the package in which the item is expected to be shipped [...i.e. *weight package data; package's number; package's zip code; package image*; par. 0014, par. 0016 and figure 2] .

Therefore, it would have been obvious to one of ordinary skill in the art at to provide Hauser with the process of returning the merchandise having the return labels for enabling a customer to ship a package to include the method of accessing the package data as taught y Holtz in order to improve the process for returning the merchandise.

Regarding claim 2, Hauser discloses the item data identifies an item type [...*different code is associate to each type of merchandise*; col. 8, lines 23-30].

Regarding claim 3, Hauser discloses the item data identifies an item value [...*value of the merchandise*; col. 2, lines 53-56].

Regarding claim 4, Hauser discloses transaction data is a transaction identifier [...*abstract*; col. 4, lines 9-15].

Regarding claim 5, Hauser discloses transaction data is a transaction date [col. 8, lines 59-62].

Regarding claim 6, Hauser discloses the customer data represents a shipping origin [figures 1-2].

Regarding claim 7, Hauser discloses the customer data represents customer preferences [...*data from customer request for returning merchandise*; col. 4, lines 9-15].

Regarding claim 8, Hauser discloses customer data identifies a payee of shipping costs [...*providing a prepaid shipping label (206) from merchant (202)*; figures 4 – 5].

Regarding claim 9, Holtz discloses the package data represents package weight [par. 0016].

Regarding claim 10, Holtz discloses the package data represents package size [par. 0062; figure 9].

Regarding claim 11, Hauser discloses accessing shipping rate data [...*prepaid shipping*; figure 5].

Regarding claim 12, Hauser discloses accessing carrier center location data [figures 2-3].

Regarding claim 13, Hauser discloses the carrier center location data represents bulk mail center data [figures 2-3].

Regarding claim 14, Hauser discloses a computer product for providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising programming operable to:

access item data representing at least one detail about the item [...*transmit the return merchandise data*; abstract; col.2, lines 11-13];

access transaction data representing at least one detail about the transaction associated with the item [...*data identify the merchant and the merchandise purchased by customer*; col. 2, lines 13-16; col. 4, lines 9-15];

access customer data representing at least one detail about a customer associated with the transaction [...*customer contact information; merchandise purchase by customer*; col. 2, lines 13-17; col.4, lines 9-15];

correlate the item data, transaction data, customer data, and package data, with a set of stored business rules; wherein the business rules represent guidelines for determining at least one shipping parameter selected from the group of: choice of carrier, shipping destination, shipping rate, or package disposition [... shipping parameter selected from the group of *package disposition*; figures 1-2; col. 6, lines 50-65];

generate a machine readable code, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and

identification of the transaction [...*label (52) includes the address for returns* (shipping origin) *and a bar code to identify the merchant and merchandise being returned* (identification of the transaction); *abstract*, col. 6, lines 21-27; and figures 2 and 6]; and

format the return label, such that the return label contains the machine readable code and complies with shipping label specifications of a carrier [...*return label having a machine readable code (52)* figure 2; and *is applied in the package to ship via USP or shipper*; col. 4, lines 16-30; figure 1, step 18-20].

However, Hauser fails to indicate accessing package data representing at least one detail about the package in which the item is expected to be shipped.

In the similar process for returning the merchandise, Holtz discloses accessing package data representing at least one detail about the package in which the item is expected to be shipped [...i.e. *weight package data; package's number; package's zip code; package image*; par. 0014, par. 0016 and figure 2] .

Therefore, it would have been obvious to one of ordinary skill in the art at to provide Hauser with the process of returning the merchandise having the return labels for enabling a customer to ship a package to include the method of accessing the package data as taught by Holtz in order to improve the process for returning the merchandise.

Regarding claim 15, Hauser discloses access at least one of the group of item data, customer data, transaction data, or product data, via a remote data communications link [figures 3 and 5].

Regarding claim 16, Hauser discloses further operable to access shipping rate data [...prepaid shipping; figure 5].

Regarding claim 17, Hauser discloses accessing carrier center location data [figures 2-3].

Regarding claim 18, Hauser discloses the carrier center location data represents bulk mail center data [figures 2-3].

Regarding claim 19, Hauser discloses wherein the item data identifies an item type [...*different code is associate to each type of merchandise*; col. 8, lines 23-30].

Regarding claim 20, Hauser discloses wherein the item data identifies an item value [...*value of the merchandise*; col. 2, lines 53-56].

Regarding claim 21, Hauser discloses wherein the transaction data is a transaction identifier [...*abstract*; col. 4, lines 9-15].

Regarding claim 22, Hauser discloses wherein the transaction data is a transaction date [col. 8, lines 59-62]...

Regarding claim 23, Hauser discloses wherein the customer data represents a shipping origin [figures 1-2].

Regarding claim 24, Hauser discloses wherein the customer data represents customer preferences [...*data from customer request for returning merchandise*; col. 4, lines 9-15].

Regarding claim 25, Hauser discloses wherein the customer data identifies a payee of shipping costs [...providing a prepaid shipping label (206) from merchant (202); figures 4 – 5].

Regarding claim 26, Holtz discloses wherein the package data represents package weight [par. 0016].

Regarding claim 27, Holtz discloses wherein the package data represents package size [par. 0062; figure 9].

Regarding claim 30, the teaching of Hauser is indicated above, Holtz discloses wherein the programming is further operable to access package data representing at least one detail about the package in which the item is expected to be shipped, and to further correlate package data with the business rules [...i.e. *weight package data; package's number; package's zip code; package image*; par. 0014, par. 0016 and figures 2 -5].

Therefore, it would have been obvious to one of ordinary skill in the art at to provide Hauser with the process of returning the merchandise having the return labels for enabling a customer to ship a package to include the method of accessing the package data as taught y Holtz in order to improve the process for returning the merchandise.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
9. The US Patent Application Publication to Tibbs et al. disclose systems and methods for generating and providing an electronic return shipping label to a customer to allow the customer to return goods to a merchant; and to Bloom discloses a method and system for the efficient bulk package delivery for recipients; and to Sundel disclose a method for facilitating the shipment of a package containing items from a sender to recipient.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689